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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/763,352
Filing Date: January 23, 2004
Appellant(s): CARLSON ET AL.

Walter W. Karnstein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/17/2008 appealing from the Office action mailed
12/13/2007

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claim 5 is allowed.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claim 5 over Endo et al. (5,894,318) in view of Ohno et al. (4,549,803) has been withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,894,318	Endo et al.	4-1999
4,549,803	Ohno et al.	10-1985
6,816,178	Fukushima	9-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the nature which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103 (a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6, 8-9, 12-14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al. (5,894,318) in view of Ohno et al. (4,549,803).

Endo et al. teaches a method of using a printing device comprising receiving a laminate request via the user interface, adjusting the fusing temperature and speed, laminating a document surrounded by laminate sheet material (figures 4, 6, 9a, 9b, 10). The document and laminate sheet materials are inserted through the manual feed tray and bypass the transfer mechanism before being fused in the toner fuser (column 11, lines 25-53). Endo et al. does not teach adjusting the characteristics of the toner fuser.

Ohno et al. teaches changing the characteristics of the toner fuser based on the type of media, such as OHP transparencies which are made of a resin like a laminate sheet, and adjusting the characteristics of the toner fuser such as the speed or pressure (column 6, lines 44-55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of Ohno et al. with the image forming device of Endo et al. to ensure proper fusing of a varied type of media (Ohno et al., column 3, lines 13-31).

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo et al. in view of Ohno et al. in view of Fukushima.

Endo et al. does not discuss displaying instructions on the display device. Fukushima teaches displaying manual feed instruction on the device display and instructions on how to operate the other features of the printing device. It would have been obvious to one of ordinary

skill in the art at the time the invention was made to use the teaching of Fukushima with the printing device of Endo et al. to provide instructions that are needed for operating the printing device.

(10) Response to Argument

Appellants argue that the combination of Endo with Ohno is inappropriate and does not make obvious the subject matter of the pending claims. Ohno is not of the same field of endeavor as Endo, as it does not address the same technical problem. The references must suggest the desirability, and thus, the obviousness of making the combination and that the Examiner missed that Ohno and Endo teach solutions to different technological problems and thus are nonanalogous, inappropriate for use in a rejection under 35 U.S.C. § 103.

However, the teaching of Ohno et al. is analogous art because it is applicable to toner fusers. Ohno et al. teaches changing the toner fuser characteristics based on media type including OHP resin media and Endo teaches a toner fuser that fuses media and laminates paper type media with resin media. Endo and Ohno are both in the field of image forming and both are concerned with controlling the toner fuser in an image forming device.

Appellant argues that the Office action states that "Ohno et al. teaches changing the characteristics of the toner fuser...when laminating a document with laminating material (column 6, lines 44-55)." (Final Office action, pg. 3). As such, Ohno does not teach adjusting the temperature and speed of a toner fuser when laminating a document.

However, the final office action does not contain this statement regarding Ohno. The final office action states that Ohno is relied upon to teach that the fuser temperature should be based on the media being a standard media or non-standard media type (Final Office action, page 4). Ohno is not relied upon to teach lamination. The instant invention is concerned with laminating different resin sheets with different types of media such as thick and thin paper media. It is important to note that Ohno teaches adjusting the fuser characteristics for resin media, which is the same type of material as a laminate sheet discussed in the instant invention.

Appellant argues secondly that the rejections in view of Endo and Ohno are inappropriate because Ohno is not analogous art with Endo, or with the present disclosure, when the disclosure of Ohno is considered as a whole, as it must be.

However, both Ohno and Endo are concerned with the heating of resin sheets with a fuser device in an image forming device.

Appellants argue that Ohno is directed toward determining the optimal conditions useful for fixing toner to a resin-based overhead projector sheet. In contrast, the claimed invention is directed toward partially melting, and fixing together, a resin sheet with another resin sheet or with a media sheet.

However, the instant invention is concerned with fusing together a resin sheet and a media sheet, not two resin sheets. The detailed description does not discuss fusing two resin sheets together. Endo teaches fusing a resin sheet with a media sheet. Ohno is directed to properly fusing different types of media sheets. Therefore, one of ordinary skill in the art would

when fusing a media sheet (of some type) and a laminate sheet, would find the teaching of Ohno to be on point to ensure that different types of media sheets are properly addressed.

Appellants' argue that Ohno teaches away from its combination with Endo. In switching from a printing mode to a laminating mode, Endo teaches that one should slow down a transport speed by about 90% and simultaneously increase a temperature within a printing device (Endo, col. 11, lines 25-35). In contrast, Ohno teaches that when switching from printing on paper to printing on a resin sheet one should slow down the transport speed by about 80% but also decrease the temperature. (Ohno, col. 8, lines 27-42).

However, Ohno does not teach away from its combination with Endo. Endo et al. teaches a laminating mode using resin media with paper media which is accomplished by adjusting the toner fuser and Ohno et al. teaches adjusting the toner fuser characteristics based on the type of paper or resin media. Ohno teaches when fusing a single resin sheet that the speed and temperature of the fuser should be different from when paper media is fused. Endo teaches laminating two sheets, one resin and one paper type media. Endo does not address changing the fuser temperature or speed based on different paper media types. Therefore, Endo et al. in view of Ohno et al. suggest adjusting the toner fuser characteristics for the paper media and resin (laminate) media combination to be properly laminated. One of ordinary skill in the art viewing both Endo and Ohno would know to select an appropriate fuser characteristic for proper lamination based on, or at least considering, the type of paper media.

Appellant's argue that an automatic feed tray, as recited in claim 9, does not require a user to insert a media sheet immediately prior to performing a laminating function, as it already contains the necessary materials and can be used as a source of materials independently of a "user insert[ing] a media sheet."

However, appellant has argued with respect to claim 9 that Endo et al. does not teach an automatic feed tray. However, the manual feed tray is automatic since the user inserts a media sheet and the sheet is then automatically fed to the image forming section. Applicant argues with respects to claims 13-14 and 16-17 that the combination does not include a selectively operable bypass of the image transfer mechanism. However, the transfer mechanism is bypassed in the combination just as in the instant invention where a composite media goes through the media path to the fuser without having an image transferred upon it. Further, Ohno, which is a part of the combination, teaches an automatic feed tray for feeding all sizes and types of media including resin sheets.

Appellants' argues that Ohno teaches altered resin-printing conditions that are incompatible with performing a lamination function in a printer! This makes clear that Ohno attempts to, and does, solve a different problem than Endo, and thus is not analogous art to Endo and the claimed invention.

However, Ohno is not relied upon for teaching lamination and the applied art does not have to solve the same problem. Ohno teaches how to fuse different paper and resin media. Endo is concerned with laminating a composite job made of a (resin media) laminate and a media sheet. Ohno addresses the media sheet.

Appellants note, however, that the Examiner still has not pointed to a disclosure of changing the pressure of a toner fuser in either Endo or Ohno.

Appellant arguments with respect to changing the pressure during lamination based on identifying the composite sheets are persuasive. The applied art does not suggest a change in pressure during lamination.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Quana M. Grainger

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TQAS - TC 2800